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**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Janssen, et al.

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For: SERVER-BASED COMPUTING ENVIRONMENT : Atty Docket No. DVME-1018US

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**APPEAL BRIEF**

This is an appeal of the rejections set forth in the Final Rejection dated July 3, 2007, (hereinafter referred to as "the Final Rejection") in relation to the above-identified application. Appellant respectfully submits that the rejections in the Final Rejection were made in error, and that these rejections should be reversed for the reasons set forth below.

**I. The Real Party in Interest**

The real party in interest in the present appeal is Real Enterprise Solutions Development, B.V., Nieuwe 'S-Gravelandsweg 60, 1406 NH Bussum, Netherlands, to whom an undivided interest in the above-captioned application has been assigned by virtue of an assignment by the inventors to Real Enterprise Solutions Development, B.V. recorded on June 19, 2002, at reel 013004, frame 0915.

**II. Related Appeals and Interferences**

The Appellant is unaware of any pending appeals or interferences related to the present appeal.

**III. The Status of the Claims**

Claims 11-17 have been canceled without prejudice to resubmission. Claims 1-10 and 18-19 are currently pending in the present application and stand rejected in the Final Rejection. The rejections of claims 1-10 and 18-19 are hereby appealed. A copy of the currently pending claims 1-10 and 18-19 is attached as an appendix hereto.

**IV. The Status of any Amendments Filed after Final Rejection**

No amendments have been filed after the Final Rejection dated July 3, 2007.

**V. Summary of the Claimed Subject Matter**

The present invention, as claimed in independent claim 1, relates to a server-based computing system (page 1, lines 3-4 of the specification). The server-based computing system includes at least one server 1 and at least one client computer 5, connected to the server 1 through a network 2 (page 1, lines 3-5 of the specification). The server 1 includes means for providing the client computer 5 with a user interface (page 1, lines 6-7, page 2, lines 20-23, page 4, lines 21-23, page 6, lines 1-12, page 8, lines 1-3 and page 11, lines 3-6 of the specification). This is a means-plus-function limitation in accordance with 35 U.S.C. §112(6) and the corresponding structure for performing the function is identified at page 6, lines 13-15 and page 8, lines 1-3 and 7-8 of the specification.

The client computer 5 includes an input device 8 for providing input to an application through the user interface (page 1, lines 7-9 of the specification). The client computer 5 also includes a display device 7 for presenting output from an application through the user interface (page 1, lines 9-10 of the specification). The server 1 also includes means for running the application (page 1, lines 10-11 of the specification). This is a means-plus-function limitation in accordance with 35 U.S.C. §112(6) and the corresponding structure for performing the function is identified at page 3, line 36 to page 4, line 10 of the specification.

The client computer 5 also includes means 6 for locally running at least one further application (page 1, lines 11-13 of the specification). This is a means-plus-function limitation in accordance with 35 U.S.C. §112(6) and the corresponding structure for performing the function is identified at page 4, line 34 to page 5, line 4 of the specification.

The system also includes means for controlling the locally run applications through the user interface provided by the server 1 (page 2, lines 20-23 of the specification). This is a means-plus-function limitation in accordance with 35 U.S.C. §112(6) and the corresponding structure for performing the function is identified at page 7, lines 7-9, element 13 of Figure 2A and page 10, lines 16-21 (e.g. interface management program) of the specification.

The system is configured to enable the server 1 to control the display on a screen of the display device 7 of a screen area having contents generated locally on the client computer 5 (page 6, lines 3-25, page 8, lines 1-10 and Figures 2A-2B of the specification).

By virtue of the system of claim 1, a system manager can centrally manage the user interface. Updates, for example, need only be installed once. It is not necessary to use cumbersome methods for remotely installing updates on each client computer or to install updates from a CD on each client computer. Users can work on a different client computer without having to adjust the display settings according to their preferences or wait until their settings have been downloaded into the client computer. (See page 2, lines 27-34 of the specification for the advantages recited in this paragraph).

Thus, it is possible to integrate local and central computing environments so that a user will not notice any difference between locally and centrally run applications (page 3, lines 3-6 of the specification). Also, it is not necessary to switch between separate user interfaces nor is it necessary to overlay one user interface over another with the consequent deterioration of the quality of the display and control that is often associated therewith (page 3, lines 6-10 of the specification).

Claim 4 requires a system according to claim 1 further including means 13, 14, 15 for presenting an overview of available applications installed on the server 1 and on the client

computer 5 through the user interface. This is a means-plus-function limitation in accordance with 35 U.S.C. §112(6) and the corresponding structure for performing the function is identified at page 7, lines 7-11 and elements 13-15 of Figure 2A of the specification.

Claim 6 requires a system according to claim 1 further including means for generating a merged local client screen 16, for display on the display device 7. This is a means-plus-function limitation in accordance with 35 U.S.C. §112(6) and the corresponding structure for performing the function is identified at page 7, lines 24-36 of the specification.

Claim 7 requires a system according to claim 6, wherein the server 1 comprises means for controlling the display of the merged local client screen 16 on the display device 7. This is a means-plus-function limitation in accordance with 35 U.S.C. §112(6) and the corresponding structure for performing the function is identified at page 8, lines 1-10 of the specification.

Claim 8 requires a system according to claim 7, wherein the client computer 5 includes means for generating a local client screen area 9, comprising visual output from the locally run applications, and the server 1 comprises means for generating a screen area 10 (page 7, lines 24-35 of the specification). The system comprises means for merging the local client screen area 9 and the screen area 10 generated by the server 1, to form the local client screen 16. This is a means-plus-function limitation in accordance with 35 U.S.C. §112(6) and the corresponding structure for performing the function is identified at page 7, lines 24-36 of the specification.

Claim 9 requires a system according to claim 8, including means for automatically updating the local client screen (16), when changes occur in the local client screen area (9) and/or in the screen area (10) generated by the server (1). This is a means-plus-function limitation in accordance with 35 U.S.C. §112(6) and the corresponding structure for performing the function is identified at page 8, lines 11-27 of the specification.

Claim 18 relates to a computer program stored on a computer readable medium (page 6, lines 13-15 and page 8, lines 1-10 of the specification). The computer program can be loaded onto a server 1 connected through a network 2 to a client computer 5 (page 6, lines 13-15 and page 8, lines 1-10 of the specification). The client computer 5 comprises an input device 8 for providing

input to an application through a user interface and a display device 7 for presenting output from an application through the user interface (page 1, lines 7-10 of the specification).

The server 1 includes means for running the application (page 1, lines 10-11 of the specification). This is a means-plus-function limitation in accordance with 35 U.S.C. §112(6) and the corresponding structure for performing the function is identified at page 3, line 36 to page 4, line 10 of the specification.

The client computer 5 comprises means 6 for locally running at least one further application (page 1, lines 11-13 of the specification). This is a means-plus-function limitation in accordance with 35 U.S.C. §112(6) and the corresponding structure for performing the function is identified at page 4, line 34 to page 5, line 4 of the specification.

The server and client computer 5 comprise means for controlling the locally run applications through a user interface provided by the server 1 (page 2, lines 20-23 of the specification). This is a means-plus-function limitation in accordance with 35 U.S.C. §112(6) and the corresponding structure for performing the function is identified at page 7, lines 7-9, element 13 of Figure 2A and page 10, lines 16-21 (e.g. interface management program) of the specification.

The computer program, when run on the server 1 instructs the server 1 to provide the client computer 5 with the user interface and the server controls the display on a screen of the display device 7 of a screen area having contents generated locally on the client computer (page 6, lines 3-25, page 8, lines 1-10 and Figures 2A-2B of the specification).

The computer program of claim 18, when run on a system such as that shown in Figure 1 of the specification, provides similar benefits as are provided by the system of claim 1 described above.

Claim 19 relates to a computer program stored on a computer readable medium (page 6, lines 13-15 and page 8, lines 1-10 of the specification). The computer program can be loaded onto a computer, the computer being connected through a network 2 to a server 1 (page 6, lines 13-15 and page 8, lines 1-10 of the specification). The computer includes an input device 8 for

providing input to an application through a user interface and a display device 7 for presenting output from an application through the user interface (page 1, lines 7-10 of the specification).

The server 1 includes means for running an application (page 1, lines 10-11 of the specification). This is a means-plus-function limitation in accordance with 35 U.S.C. §112(6) and the corresponding structure for performing the function is identified at page 3, line 36 to page 4, line 10 of the specification.

The computer comprises means 6 for locally running at least one further application (page 1, lines 10-13 of the specification). This is a means-plus-function limitation in accordance with 35 U.S.C. §112(6) and the corresponding structure for performing the function is identified at page 4, line 34 to page 5, line 4 of the specification.

The computer program, when run on the computer, causes the computer to accept the user interface which is provided by the server 1 (page 8, lines 1-10 of the specification). The user interface is configured for controlling the at least one locally run application (page 6, lines 3-12 and page 10, lines 16-26 of the specification). The computer program further causes the computer to display a screen area having contents generated locally on the client computer according to display properties specified by the server 1 (page 6, lines 3-25, page 8, lines 1-10 and Figures 2A-2B of the specification).

The computer program of claim 19, when run on a system such as that shown in Figure 1 of the specification, provides similar benefits as are provided by the system of claim 1 described above.

**VI. Grounds of Rejection to be Reviewed on Appeal**

Appellant believes that the grounds of rejection to be reviewed on appeal may be concisely summarized as follows:

(A) Claims 1-10 and 18-19 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,909,545 to Frese (hereinafter "Frese"), and

(B) Claims 1-10 and 18-19 stand rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,613,090 to Willems (hereinafter "Willems").

**VII. Argument****A. The Rejection of Claims 1-10 and 18-19 Under 35 U.S.C. §102(b) is Improper**

Claims 1-10 and 18-19 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,909,545 to Frese (hereinafter "Frese"). This same rejection was previously raised in the Office Action dated July 22, 2005, and was overcome by applicant's response filed on November 25, 2005, as indicated in the Office Action dated January 5, 2006.

**1. Independent Claim 1 and Dependent Claims 2-3, 5 and 10**

The present invention relates to a server-based computing system, including at least one server 1 and at least one client computer 5, connected to the server 1 through a network 2. The server 1 includes means for providing the client computer 5 with a user interface and means for running the application. The system also includes means for controlling the locally run applications through the user interface provided by the server 1, and is configured to enable the server 1 to control the display on a screen of the display device 7 of a screen area having contents generated locally on the client computer.

Frese does not disclose the limitation of claim 1 which provides that, "the client computer...is configured to enable the server...to control the display on a screen of the display device of a screen area having contents generated locally on the client computer." The Final Rejection erroneously concludes that merely because Frese's client computer 16 is connected to

server 20 via a network, Frese's computer is configured to enable server 20 to control the display on a screen area on a display having contents generated locally on client computer 16, as claimed. However, merely connecting a client computer 16 to a server 20 is not sufficient to enable the server to control the display on a screen of the display device of a screen area having contents generated locally on the client computer. Rather, in order for the server to be enabled to perform this function the server must also include some hardware or software for controlling the display of the local client computer. (See page 11, lines 3-6 of the specification).

According to *Phillips v. AWH Corp.*, 415, F.3d 1303, 75 U.S.P.Q.2d 1321 (Fed. Cir. 2005), the claims and specification are the cornerstones of claim construction. In the present case, the claims and specification make it clear that in order for the server to be enabled to control the display on a screen of the display device of a screen area having contents generated locally on the client computer, the server must include some hardware or software for controlling the display of the local client computer. (See page 11, lines 3-6 of the specification). The Examiner has not given due consideration to this portion of the specification when giving the claims their broadest reasonable interpretation. This is evidenced by the fact that the Final Rejection does not explain how a server that is not provided with hardware or software for controlling the display of the local client computer would be enabled to perform this function by merely being connected to the local client computer. Moreover, there is no evidence in the record that existing servers were provided with such hardware or software prior to applicant's priority date.

In addition, in *Boston Sci. Corp. v. Cordis Corp.*, 2006 U.S. Dist. LEXIS 94329 (D. Cal. 2006), the court interpreted the claim language "configured to" as meaning, "intentionally and specifically made to act in a certain way." Therefore, without means intentionally and specifically made to control the display of the local computer, Frese does not anticipate claim 1.

That the Examiner's claim interpretation is erroneous is further demonstrated by the statement that,

The claims [sic – claim 1] specify that the system is 'configured to enable' the server to control the display. Thus, the system merely needs to be capable of enabling the server to control the display." (emphasis original)



See page 3, lines 1-3 of the Final Rejection. Thus, the Examiner mistakenly equates the language “configured to” with the language, “capable of.” This is an error since “configured to” clearly has a different meaning than “capable of” as discussed above.

The Examiner goes on to state that,

To be capable of enabling the server to control a display at the client the server needs to be: (1) capable of being provided with means for controlling the display of the client; and (2) connected to the client via some communication network.”  
(emphasis original)

See page 3, lines 3-6 of the Final Rejection. Thus, the Examiner strays even further from the actual language of claim 1, namely, “configured to” to the erroneous interpretation of this phrase as meaning, “capable of being provided with.” Clearly, these two phrases are not equivalent. Moreover, the Examiner has provided no evidence or legal support for the conclusion that these phrases are equivalent. Thus, the Examiner’s interpretation of the language, “configured to” as meaning, “capable of being provided with” is clearly erroneous and unsupported by evidence or law and thus should be reversed.

This quote from page 3, lines 3-6 of the Final Rejection also highlights two other flaws in the Examiner’s reasoning. First, this quote admits that more than a mere connection between the server and the client is required to meet the disputed limitation of claim 1. However, the Examiner has not demonstrated that Frese discloses more than a mere connection between the client computer and the server. Specifically, the Examiner has not identified any structure on the client computer configured to enable the server to control the display on a screen of the display device and thus Frese does not meet this claim limitation.

The second flaw in the Examiner’s reasoning is shown by the fact that the Examiner states that, “...the server needs to be: (1) capable of being provided with means for controlling the display of the client; and (2) connected to the client via some communication network.” However, claim 1 of the present application requires that the client computer, not the server, is configured to

enable the server..." Thus, it is the client computer of claim 1 that must be configured to enable... and not the server as the Examiner mistakenly concludes.

Instead of the means claimed in claim 1 of the present application, Frese uses an applet (Remote Display Module (RDM) 18) running on a client computer to control the display on the user system 16 of Frese. The Examiner concedes this point at page 3, lines 20-21 of the Final Rejection. Thus, Frese does the opposite of what is claimed in the present claim 1, namely, controls the display of the local client computer using the client computer rather than the server. See col. 9, line 63 to col. 10, line 4 of Frese. Therefore, the client computer of Frese is not configured to enable the server to control the display as required by claim 1 but rather, the opposite is true, the client computer of Frese is configured to enable the client computer to control the display.

Moreover, the HTML page described at col. 7, lines 33-35 of Frese, is not an application that is run locally, as the Examiner suggests. Instead, this HTML page is provided for the purpose of describing available application programs. See col. 7, lines 33-35 of Frese. The other modules running on the server of Frese do not specify display properties of an interface to an application running locally on the client.

Frese also discloses that an AIM (application interception module) converts the I/O streams for the application launched on the RAS (remote application server) into remote control protocol messages. See col. 13, lines 60-63 of Frese. Frese also teaches that a protocol translation and optimisation module (PTOM) encapsulates known remote control protocol messages in the remote control protocol recognized by the RDM. See col. 8, lines 46-48 of Frese. The AIM, PTOM and RDM each play a role in controlling applications running on the server, but do not control the display of a user interface which can control an application running locally on the client computer as required by the language of the present claim 1. For at least these reasons the limitations of claim 1 are not met by Frese.

The Examiner takes the position that server 20 of Frese controls some aspects of the display by specifying the parameters of RDM applet 18, and thus meets the requirements of claim

1. See paragraph 2-2 on pages 3-4 of the Final Rejection. This analysis of Frese is incorrect. Rather, RDM applet 18 of Frese controls the display of a screen area (see col. 6, lines 60-64 of Frese). Specifically, Frese indicates that, "Once RDM 18 is executing on user system 16, it provides a seamless and transparent interface between the local resource interface of system 16 and application program 22." See col. 6, lines 61-64 of Frese. The RDM 18 of Frese executes on user system 16 (see col. 6, lines 61-62 of Frese) and thus user system 16 of Frese controls the display by executing the RDM 18.

In addition, Frese does not disclose that the server specifies RDM 18's parameters, as the Examiner suggests. Rather, as described in Frese, the executable code for RDM 18 is transported in a file across the network prior to execution of this executable code on user system 16 (see col. 9, lines 61-66 of Frese). The applet tag of the HTML document is used to select which RDM applet is to be transmitted to the local computer for execution on the local computer and not for the purpose of controlling display parameters as the Examiner suggests (see col. 10, lines 5-14 of Frese). The RDM 18 of Frese, thus controls the display. The applet tag merely selects which RDM 18 will be used to control the display but does not itself control the display.

Another flaw in the Examiner's reasoning is that the Examiner assumes that the HTML document containing the applet tag is stored at the server 20 of Frese. See page 4, lines 2-3 of the Final Rejection. However, the Examiner does not cite any support in Frese for this conclusion since this conclusion is not supported by Frese. Rather, Frese teaches that the server, "...supports the HTTP communications protocol for presenting and transmitting HTML documents over the internet." See col. 7, lines 29-31 of Frese. Thus, Frese indicates that the server 20 can present and transmit HTML documents over the internet, but nowhere indicates that these HTML documents are actually stored at server 20 as the Examiner assumes.

RDM 18 of Frese does not generate content. The Examiner takes the position that the application window of Frese is "content." See page 11, lines 5-8 of the Final Rejection. This is clearly incorrect since an application window is not content. Rather, in Frese RDM 18 controls a display and receives user input actions to generate and provide output to local resource interface

32 (see col. 9, line 66 to col. 10, line 4 of Frese). Finally, even when RDM 18 controls the display to display content generated locally (e.g. when displaying user input to RDM 18), this action does not involve server 20 and thus the display of the locally generated content is clearly not controlled by server 20 of Frese.

The Examiner also takes the position that it was common in the art to refer to a web page or components thereof as a user interface, citing the article, "Designing Web-Based User Interfaces" by Scott Ambler (hereinafter "Ambler") attached to the Final Rejection. First, even if it were common in the art to refer to web pages or components thereof as a user interface, this does not prove that the web page referenced in Frese is a user interface.

Second, the Examiner's analysis based on Ambler neglects to consider that claim 1 also requires that the system comprise means for controlling the locally run applications through the user interface provided by the server ). A review of Ambler indicates that Ambler does not disclose a user interface that can be used to control applications. Rather, the user interfaces discussed by Ambler are provided for the purpose of gathering information and not for controlling applications on a computer. Thus, these are completely different types of user interfaces than those referred to in claim 1 of the present application. Finally, even if the web page of Frese were a user interface as the Examiner suggests, Frese does not disclose that such web pages can be used to control applications on a computer.

Accordingly, for at least these reasons, Frese does not anticipate claim 1 of the present application since Frese does not disclose the limitation of claim 1 requiring that, "the client computer...is configured to enable the server...to control the display on a screen of the display device of a screen area having contents generated locally on the client computer." The same reasoning applies to claims 2-3, 5 and 10 since each of these claims depends from claim 1 and thus incorporate the limitations of claim 1 therein. Reversal of the Examiner's rejection of claims 1-3, 5 and 10 under 35 U.S.C. §102(b) as being anticipated by Frese is therefore requested for these reasons.

**2. Claim 4**

Claim 4 requires a system according to claim 1 including means 13, 14, 15 for presenting an overview of available applications installed on the server 1 and on the client computer 5 through the user interface. Claim 4 is novel over Frese for the reasons given above with respect to claim 1, and additionally because Frese does not disclose means for presenting an overview of available applications installed on the server through the user interface.

As far as the applicant can determine, Frese does not mention display of any applications installed on the server at all. In support of the rejection of claim 4 over Frese, the Examiner makes a vague reference to col. 6, line 39 to col. 8, line 50 and Figure 1 of Frese. A review of this portion of Frese confirms the applicant's conclusion that Frese does not mention display of any applications installed on the server.

Accordingly, for these reasons, the rejection of claim 4 under 35 U.S.C. §102(b) should be reversed. Favorable consideration and reversal of the rejection is requested.

**3. Claim 6**

Claim 6 requires a system according to claim 1 including means for generating a merged local client screen 16, for display on the display device 7. Claim 6 is novel over Frese for the reasons given above with respect to claim 1, and additionally because Frese does not disclose means for generating a merged local client screen 16, for display on the display device 7.

A merged local client screen 16 is a client screen displayed on the client computer 5 which merges the local client screen area 9 of Figure 2A with the central application screen area 10 of Figure 2A. See page 7, lines 24-27 of the specification. The local client screen area 9 is a screen area generated locally on client computer 5. See page 6, lines 30-31 of the specification. The central application screen area 10 is generated by the server 1 and includes components generated by the interface management program of server 1 and a display of output from applications running on the server 1, if any. See page 6, lines 32-37 of the specification. Thus, the merged local client screen 16 of claim 6 includes both: (1) a screen area generated locally on client computer 5,

and (2) components generated by the interface management program of server 1 and a display of output from applications running on the server 1, if any.

As far as the applicant can determine, Frese does not mention display of any components generated on the server 20 nor does Frese mention running any applications on the server 20. Thus, since Frese does not include either of these features, Frese also does not have a central application screen area 10, since Frese does not even contemplate generating anything on the server 20 that is displayed by the central application screen area 10 of the present invention. Accordingly, since Frese does not have a central application screen area 10, Frese cannot have a merged local client screen 16, as claimed in claim 6 since one component of the merged local client screen 16 is the central application screen area 10. Accordingly, since Frese does not have a merged local client screen 16, Frese also lacks the claimed means for generating a merged local client screen 16, for display on the display device 7 of claim 6.

In support of the rejection of claim 6 over Frese, the Examiner makes a vague reference to col. 6, line 39 to col. 8, line 50 and Figure 1 of Frese. A perusal of this portion of Frese confirms the applicant's conclusion that Frese does not include the features of claim 6 for the reasons given above.

Accordingly, for these reasons, the rejection of claim 6 under 35 U.S.C. §102(b) should be reversed. Favorable consideration and reversal of the rejection is requested.

#### **4. Claims 7-8**

Claim 7 requires a system according to claim 6 including means for controlling the display of the merged local client screen 16, for display on the display device 7. Claim 8 depends from claim 7. Claim 7 is novel over Frese for the reasons given above with respect to claim 6, and additionally because Frese does not disclose means for controlling the display of a merged local client screen 16, for display on the display device 7.

As discussed above in reference to claim 6, Frese does not have a merged local client screen 16, as claimed in claim 7. Accordingly, since Frese does not have a merged local client

screen 16, Frese also lacks the claimed means for controlling the merged local client screen 16, for display on the display device 7 of claim 7 since there is no merged local client screen 16 in Frese to control.

In support of the rejection of claim 7 over Frese, the Examiner makes a vague reference to col. 6, line 39 to col. 8, line 50 and Figure 1 of Frese. A review of this portion of Frese confirms the applicant's conclusion that Frese does not include the features of claim 7 for the reasons given above.

Accordingly, for these reasons, the rejection of claim 7 under 35 U.S.C. §102(b) should be reversed. Also, since claim 8 depends from claim 7, the rejection of claim 8 should also be reversed for the same reasons as the rejection of claim 7. Favorable consideration and reversal of the rejection is requested.

### **5. Claim 9**

Claim 9 requires a system according to claim 8, including means for automatically updating the local client screen 16, when changes occur in the local client screen area 9 and/or in the screen area 10 generated by the server 1. Claim 9 is novel over Frese for the reasons given above with respect to claims 7-8, and additionally because Frese does not disclose means for automatically updating the local client screen 16, when changes occur in the local client screen area 9 and/or in the screen area 10 generated by the server 1.

As discussed above in reference to claims 7-8, Frese does not have a merged local client screen 16, as claimed in claim 9. Accordingly, since Frese does not have a merged local client screen 16, Frese also lacks the claimed means for updating the merged local client screen 16, for display on the display device 7 of claim 9 since there is no merged local client screen 16 in Frese to update.

In support of the rejection of claim 9 over Frese, the Examiner makes a vague reference to col. 6, line 39 to col. 8, line 50 and Figure 1 of Frese. A review of this portion of Frese confirms

the applicant's conclusion that Frese does not include the features of claim 9 for the reasons given above.

Accordingly, for these reasons, the rejection of claim 9 under 35 U.S.C. §102(b) should be reversed. Favorable consideration and reversal of the rejection is requested.

#### **4. Claim 18**

Claim 18 requires that the server control the display on a screen of the display device. The Examiner takes the position that server 20 of Frese controls the display as required by claim 18 by specifying the parameters of RDM 18. This is incorrect. Rather, RDM 18 of Frese controls the display of a screen area (see col. 6, lines 60-64 of Frese). Specifically, Frese indicates that, "Once RDM 18 is executing on user system 16, it provides a seamless and transparent interface between the local resource interface of system 16 and application program 22." See col. 6, lines 61-64 of Frese. The RDM 18 of Frese executes on user system 16 (see col. 6, lines 61-62 of Frese) and thus user system 16 of Frese controls the display by executing the RDM 18.

In addition, Frese does not disclose that the server specifies RDM 18's parameters, as the Examiner suggests. Rather, as described in Frese, the executable code for RDM 18 is transported in a file across the network prior to execution of this executable code on user system 16 (see col. 9, lines 61-66 of Frese). The applet tag of the HTML document is used to select which RDM 18 is to be transmitted to the local computer for execution on the local computer and not for the purpose of controlling display parameters as the Examiner suggests (see col. 10, lines 5-14 of Frese).

RDM 18 of Frese does not generate content. The Examiner takes the position that the application window of Frese is "content." This is clearly incorrect since an application window is not content. Rather, in Frese RDM 18 controls a display and receives user input actions to generate and provide output to local resource interface 32 (see col. 9, line 66 to col. 10, line 4 of Frese). Finally, even when RDM 18 controls the display to display content generated locally (e.g.



when displaying user input to RDM 18), this action does not involve server 20 and thus the display of the locally generated content is clearly not controlled by server 20 of Frese.

Accordingly, for at least these reasons, Frese does not anticipate claim 18 of the present application since Frese does not disclose the limitation of claim 18 requiring that, “the server controls the display on a screen of the display device of a screen area having contents generated locally on the client computer.” Reversal of the Examiner’s rejection of claim 18 under 35 U.S.C. §102(b) as being anticipated by Frese is therefore requested.

### **5. Claim 19**

Frese does not anticipate claim 19 since Frese does not disclose a computer program that, when run on the computer, causes the computer to accept a user interface provided by the server for controlling the locally run applications. Also, Frese does not disclose a system which displays a screen area having contents generated locally on the client computer according to display properties specified by the server.

RDM 18 of Frese controls the display of a screen area (see col. 6, lines 60-64 of Frese). Specifically, Frese indicates that, “Once RDM 18 is executing on user system 16, it provides a seamless and transparent interface between the local resource interface of system 16 and application program 22.” See col. 6, lines 61-64 of Frese. The RDM 18 of Frese executes on user system 16 (see col. 6, lines 61-62 of Frese) and thus user system 16 of Frese controls the display by executing the RDM 18. Thus, the Examiner’s position that server 20 of Frese provides the user interface as required by claim 19, is clearly incorrect since user system 16 of Frese provides the user interface of Frese.

The Examiner also alleges that in Frese a web page can be a user interface as claimed in claim 19 of the present application. This is incorrect because the Examiner ignores the claim language of claim 19 requiring that the user interface control locally run applications. Browser 30 generated by RDM 18 of Frese would thus be a user interface that controls the applications (col. 7 lines 16-27 of Frese). Frese does not disclose a web page that controls applications, contrary to

the Examiner's position. Note that a web page is not a browser, but rather a browser may display a web page.

In the user interface of Frese, browser 30, is not controlled or provided by server 20, but instead is controlled and provided by local computer 16. For example, Frese states that, "User system 16 also includes local resource interface 32 which couples application programs on system 16, such as browser 30, to input/output (I/O) devices such as a mouse, keyboard or monitor." See col. 7, lines 1-5 of Frese. Therefore, since browser 30 executes on user system 16, RDM 18 controls it since Frese indicates that, "Once RDM 18 is executing on user system 16, it provides a seamless and transparent interface between the local resource interface of system 16 and application program 22." See col. 6, lines 61-64 of Frese. Thus, Frese does not disclose that the server 20, as required by claim 19, specifies the display properties of the interface.

The Examiner also says that the display properties of Frese are the applet parameters specified in an applet tag. However, this is not the case. The applet tags of Frese only used to select the proper RDM 18 to transmit to the local computer to control the display properties and not for the purpose of controlling display parameters as the Examiner suggests (see col. 10, lines 5-14 of Frese).

Accordingly, for these reasons, the rejection of claim 19 under 35 U.S.C. §102(b) over Frese should be reversed. Favorable consideration and reversal of the rejection is requested.

### **B. The Rejection of Claims 1-10 and 18-19 Under 35 U.S.C. §103(a) is Improper**

Claims 1-10 and 18-19 have been rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,613,090 to Willems (hereinafter "Willems").

#### **1. Claims 1-10**

Willems discloses a personal computer in a computer network which is capable of seamlessly running disparate graphical user interfaces (GUIs) without requiring extraneous system resources (col. 1, lines 9-13 of Willems). Willems discloses running Microsoft Windows®

and X-Windows® applications simultaneously. Willems provides a consistent and uniform user interface when a client runs applications under two different operating systems with the Microsoft Windows® application running locally and the X-Windows® application running on a server.

The Examiner now relies on the prior art embodiment of Figure 8 of Willems as the starting point for the obviousness analysis. The Examiner admits that the prior art embodiment of Fig. 8 of Willems lacks two elements of claim 1, namely: (1) controlling locally run applications through the user interface provided by the server (page 14 of the Final Rejection), and (2) means for locally running at least one application (page 14 of the Final Rejection). Thus, to arrive at the subject matter of claim 1 of the present application starting from Figure 8 of Willems, the skilled person would have to: (1) choose to locate window manager 100 on X server 102, and (2) provide means for locally running at least one application.

The Examiner proposes to modify the embodiment Figure 8 of Willems to locate window manager 100 on the X server 102 to arrive at missing element (1) of claim 1 of the present application. However, this proposed modification is not consistent with the teachings of Willems. Importantly, Willems relies on the same reasoning relied on by the Examiner to modify the prior art embodiment of Figure 8 to arrive at the embodiment of Figure 9 of Willems, which is a completely different configuration than the configuration proposed by the Examiner. This alone demonstrates that the skilled person would not make the modification proposed by the Examiner based on the teachings of Willems since Willems itself makes a different modification based on the same considerations that the Examiner relies on.

Specifically, the Examiner's alleged reason for modifying the embodiment of Figure 8 of Willems to locate window manager 100 on X server 102 relies on column 14, lines 1-5 of Willems, namely, the secondary goal of Willems which is to reduce front end code. The flaw in this reasoning, however, is demonstrated by the fact that Willems, when trying to achieve this same goal, locates window manager 100 on the local computer and not on X server 102 as the Examiner proposes. See e.g. col. 13, line 59 to col. 14, line 5 of Willems. The Examiner improperly ignores this key fact in the obviousness analysis. Moreover, the skilled person would

not ignore the alternative embodiment of Figure 9 of Willems in modifying the embodiment of Figure 8, as the Examiner does, since the Figure 9 embodiment of Willems achieves both the primary and secondary stated goals of Willems, whereas the Examiner's proposed embodiment does not, as explained in detail below.

The other problem with the Examiner's proposed modification of the embodiment of Figure 8 of Willems is the same problem that led to the withdrawal of a previous, different rejection over Willems in the Office Action dated March 12, 2007, namely, that such a modification will increase network traffic contrary to the primary stated goal of Willems. In the configuration proposed by the Examiner, the window manager 100 of Figure 8 running on X server 102 will have to send commands over the network in order to control locally run applications through the user interface on the local computer. Note that Willems solution to the same problem, namely, the Figure 9 embodiment of Willems, overcomes the problem by locating both window manager 100 and X Windows on the local computer. Accordingly, the Examiner's proposed modification directly contradicts the primary stated goal of Willems which is to reduce network traffic since this arrangement would increase network traffic as compared to the alternative solution to the same problem that is expressly taught in Figure 9 of Willems. (col. 13, line 67 to col. 14, line 4 of Willems and the Field of the Invention at col. 1, lines 9-13 of Willems emphasize that, "The present invention is related to... a personal computer network which is capable of seamlessly running disparate GUIs [graphical user interfaces] and their applications without requiring extraneous system resources." (emphasis added).

The Examiner attempts to argue that the primary stated goal of Willems applies only to the embodiment of Figure 9 but not to the Examiner's proposed modification of the embodiment of Figure 8 since Figure 8 is a prior art embodiment. While this argument might apply if the Examiner were relying on the embodiment of Figure 8 itself, this argument does not apply to the present situation where the Examiner proposes a modification of the embodiment of Figure 8 to arrive at the presently claimed invention. 35 U.S.C. §103(a) requires that there be some motivation for making the Examiner's proposed change. See e.g. *KSR Intl. Co. v. Teleflex Inc.*,

550 U.S. \_\_\_, 82 USPQ2d 1385 (2007). In this case, Willems provides express motivation not to make the Examiner's proposed change but instead to modify the Figure 8 embodiment to arrive at the Figure 9 embodiment, thereby reducing network traffic and use of extraneous network resources.

In addition, the Examiner's position that the goal of reducing network traffic of Willems does not apply to the Examiner's proposed modification of Figure 8, is inconsistent with the fact that the Examiner relies on a different, less important goal that Willems also applies to modify the Figure 8 embodiment in order to arrive at the Figure 9 embodiment. Specifically, the Examiner's alleged reason for modifying the embodiment of Figure 8 of Willems to arrive at the present invention relies on column 14, lines 1-5 of Willems, namely, the secondary goal of reducing front end code, while at the same time ignoring the primary stated goal of Willems which is to reduce network traffic. Willems must be considered as a whole and thus a skilled person would not selectively rely on the secondary reduced code goal of Willems without also giving due consideration to the primary stated goal of Willems of reducing network traffic, as the Examiner does. Moreover, the skilled person would not ignore the alternative embodiment of Figure 9 of Willems in modifying the embodiment of Figure 8, as the Examiner does, since the Figure 9 embodiment of Willems achieves both the primary and secondary stated goals of Willems, whereas the Examiner's proposed embodiment does not.

The Examiner also alleges that it would be obvious in the embodiment of Figure 8 of Willems to provide means on the client computer for locally running at least one further application on the basis that this will reduce the amount of front end code required, citing column 14, lines 1-5 of Willems. However, this modification would further increase network traffic in the Examiner's proposed configuration. This is because local control of this application would require this additional means proposed by the Examiner to send additional commands over the network because in the Examiner's configuration the user interface (windows manager 100) is located on X server 102. Thus, the skilled person starting from Willems and desiring to reduce network traffic would certainly not provide means on the client computer to run applications in

the Examiner's proposed configuration since this would further increase network traffic thereby defeating the primary stated goal of Willems.

The Examiner also concludes that Willems is configured to enable the server to control the display on a screen of the display device because Willems' client computer is connected to the server via a network. The same arguments given above in relation to Frese also apply to this argument in relation to Willems. Thus, this conclusion of the Examiner is incorrect since a mere connection between the server and the client computer does not, taken alone, enable the server to control the display on a screen of the display device, as required by claim 1 of the present application.

The Examiner also relies on the fact that Willems indicates that the window manager 100 of prior art Figure 8 can be run remotely (column 13, lines 40-58 of Willems) in support of a conclusion that Willems teaches running window manager 100 on X server 102. Figure 8 of Willems, however, shows the Window manager 100 and the X server 102 as two separate elements connected by a network connection. Willems also states that running the window manager 100 remotely increases network traffic between Window manager 100 and X server 102 (column 13, lines 53-58 of Willems). Thus, even when window manager 100 of Willems is run remotely, it is not run on the X server 102 as the Examiner assumes. Thus, in the embodiment of Figure 8 of Willems, the user interface is not being provided by X server 102, but instead is provided by window manager 100, which is connected to the X server via the network (See Figure 8). Accordingly, Willems completely lacks a teaching, even in the prior art embodiment of Figure 8 now relied on by the Examiner, to configure the server to provide the user interface, as is required by the present claim 1.

The Examiner also says at page 9, item 4 of the Final Rejection that it is obvious to enable window manager 100 to control locally run applications to reduce front-end code citing column 14, lines 1-5 of Willems. This is based on the Examiner's interpretation of this portion of Willems as teaching that control of locally run applications should be handled by window manager 100. However, this part of Willems actually teaches that front-end code is reduced when control of

locally run applications is local and not when control of locally run applications is handled by window manager 100. In the Examiner's configuration, however, window manager 100 would be located on X server 102 and thus would not be local and thus this reasoning also fails.

Finally, it should be noted that the present claim 1 is neither anticipated by, nor obvious over, the embodiment of Figure 9 of Willems. On page 2 of the Office Action dated March 12, 2007, the Examiner expressly withdrew a prior rejection of all pending claims under 35 U.S.C. §102(b) over Willems. In addition, also on page 2 of that same Office Action, the Examiner, in response to applicant's arguments, discontinued reliance on the embodiment of Figure 9 of Willems in support of the rejection of all pending claims under 35 U.S.C. §103(a) and shifted to reliance on Figure 8 of Willems in support of the rejection which is presently under appeal.

Claims 2-10 all depend from claim 1 and thus incorporate the limitations of claim 1 therein. Thus, claims 2-10 are considered to be patentable over Willems for at least the same reasons as given for claim 1. For these reasons, reversal of the Examiner's rejection of claims 1-10 under 35 U.S.C. §103(a) over Willems is requested.

## **2. Claim 18**

The embodiment of Figure 8 of Willems relied on by the Examiner as the starting point for the rejection of claim 18 does not disclose the following elements of claim 18: (1) controlling locally run applications through the user interface provided by the server, and (2) means for locally running at least one application. Thus, a skilled person would have to modify the embodiment of Figure 8 of Willems to locate window manager 100 on X server 102 to meet limitation (1) of claim 18 and to provide a means for locally running at least one application to meet limitation (2) of claim 18. These are essentially the same modifications proposed by the Examiner in support of the rejection of claim 1 discussed in detail above. Again, the skilled person would not modify the embodiment of Figure 8 of Willems, wherein the window manager 100 is run remotely and not on X server 102, to include either of these two missing features of claim 18 since such modifications would increase network traffic, as discussed above, thereby

directly contradicting the primary stated goal of Willems to decrease network traffic and reduce the use of extraneous network resources.

As discussed above in detail in relation to the rejection of claim 18 over Frese, claim 18, as amended, requires that the server control the display on a screen of the client computer. The Examiner says that the embodiment of Figure 8 of Willems teaches this element of claim 18 on the basis that window manager 100, when run remotely, meets this limitation. However, Figure 8 of Willems and the description thereof make it clear that even when window manager 100 is run remotely, it is not run on X server 102 of Willems, but rather is connected to X server 102 of Willems via the network (column 13, lines 53-58 and Figure 8 of Willems). Thus, contrary to the Examiner's assertion, X server 102 of Figure 8 does not control the display as required by claim 18 even when window manager 100 of Willems is run remotely.

For these reasons, reversal of the Examiner's rejection of claim 18 under 35 U.S.C. §103(a) over Willems is requested.

### 3. Claim 19

For the reasons discussed above, Figure 8 of Willems does not disclose the following elements of claim 19: (1) controlling locally run applications through a user interface provided by the server, and (2) means for locally running at least one application. In addition, the Examiner admits that Willems also lacks a third element of claim 19, namely, (3) that the computer program, when run on the computer, causes the computer to display a screen area having contents generated locally on the client computer according to display properties specified by the server. Nowhere does Willems teach that the windows manager 100 should be located on X server 102, nor does Willems teach that the display properties of a display should be specified by X server 102. Moreover, controlling the display properties of the display on the local computer using X server 102 would also increase network traffic since this would require X server 102 to communicate the display properties over the network to the local computer.



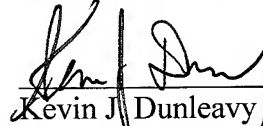
Again, the skilled person would not modify the embodiment of Figure 8 of Willems, to run window manager 100 on X server 102, or to include either of the other two missing features of claim 19, since each of these modifications proposed by the Examiner would increase network traffic, thereby directly contradicting the primary stated goal of Willems.

In support of the rejection of claim 19, the Examiner additionally makes the conclusory statement that it was well known in the art to provide a client computer with means for running locally run applications and therefore, it would be obvious to provide this feature in the Examiner's proposed configuration. However, the Examiner misunderstands the obviousness analysis here. The mere fact that in some network configurations, client computers are provided with means for running locally run applications does not make it obvious to employ this feature in any network configuration. First, the provision of this means requires additional resources on the client computer which would increase cost. Second, and most importantly, if following the teachings of Willems when configuring the network, a skilled person would not run applications locally on a client computer in the network configuration proposed by the Examiner since this would further increase network traffic. Note that running an application on the client computer would require communication of all actions of the application from the client computer across the network to the server and then back across the network from the server to the client computer for display on the local computer in the Examiner's configuration since in this configuration, the server controls the user interface on the client computer. This would result in a double increase in network traffic relative to the embodiment of Figure 9 of Willems where the user interface on the client computer is controlled by window manager 100 also located on the client computer. This would be highly undesirable in view of the primary stated goal of Willems to reduce network traffic.

For these reasons, reversal of the Examiner's rejection of claim 19 under 35 U.S.C. §103(a) over Willems is requested.

For the foregoing reasons, Appellant respectfully submits that each of the rejections should be reversed, and that the pending claims should be allowed. Such a decision is respectfully solicited.

Respectfully submitted,

  
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**VIII. Claims Appendix**

1. A server-based computing system, comprising at least one server (1) and at least one client computer (5), connected to the server (1) through a network (2), wherein the server (1) comprises means for providing the client computer (5) with a user interface, wherein the client computer (5) comprises an input device (8) for providing input to an application through the user interface and a display device (7) for presenting output from an application through the user interface, wherein the server (1) comprises means for running the application, wherein the client computer (5) comprises means (6) for locally running at least one further application, wherein the system comprises means for controlling the locally run applications through the user interface provided by the server (1), and is configured to enable the server (1) to control the display on a screen of the display device (7) of a screen area having contents generated locally on the client computer.

2. The system according to claim 1, comprising means for controlling an application running on the server (1) and further applications, running locally, through the user interface.

3. The system according to claim 1, wherein the user interface comprises means (14, 15) for initiating a locally run application.

4. The system according to claim 1, comprising means (13, 14, 15) for presenting an overview of available applications installed on the server (1) and on the client computer (5) through the user interface.

5. The system according to claim 1, wherein the user interface comprises means (11) for presenting an overview of applications running on the client computer (5) and/or the server (1).

6. The system according to claim 1, comprising means for generating a merged local client screen (16), for display on the display device (7).

7. The system according to claim 6, wherein the server (1) comprises means for controlling the display of the merged local client screen (16) on the display device (7).

8. The system according to claim 6, wherein the client computer (5) comprises means for generating a local client screen area (9), comprising visual output from the locally run applications, and the server (1) comprises means for generating a screen area (10), wherein the system comprises means for merging the local client screen area (9) and the screen area (10) generated by the server (1), to form the local client screen (16).

9. The system according to claim 8, comprising means for automatically updating the local client screen (16), when changes occur in the local client screen area (9) and/or in the screen area (10) generated by the server (1).

10. The system according to claim 1, comprising means (12, 18, 20) for selecting a running application; and means for providing input to the selected application and/or means for presenting output from the selected application on the client computer (5) through the user interface.

11-17. (Canceled)

18. A computer program stored on a computer readable medium, wherein the computer program can be loaded onto a server connected through a network (2) to a client computer (5) wherein the client computer (5) comprises an input device (8) for providing input to an application through a user interface and a display device (7) for presenting output from an

application through the user interface, wherein the server (1) comprises means for running the application, wherein the client computer (5) comprises means (6) for locally running at least one further application, and wherein the server and client computer (5) comprise means for controlling the locally run applications through a user interface provided by the server, wherein the computer program, when run on the server instructs the server to provide the client computer (5) with the user interface and the server controls the display on a screen of the display device (7) of a screen area having contents generated locally on the client computer.

19. A computer program stored on a computer readable medium, wherein the computer program can be loaded onto a computer, the computer being connected through a network (2) to a server (1), and comprising an input device for providing input to an application through a user interface and a display device for presenting output from an application through the user interface, wherein the server (1), comprises means for running an application, and wherein the computer comprises means (6) for locally running at least one further application, wherein the computer program, when run on the computer, causes the computer to accept the user interface, the user interface being configured for controlling the at least one locally run application and being provided by the server, and further causes the computer to display a screen area having contents generated locally on the client computer according to display properties specified by the server (1).

**IX. Evidence Appendix**

None

**X. Related Proceedings Appendix**

None